Remarks

Upon entry of this amendment, claims 16-42, 44-47, 50, 51, 53, and 57-70 are pending in the above-captioned application. Claims 71-77 have been canceled without prejudice or disclaimer. Applicants respectfully reserve the right to pursue the canceled subject matter in later filed continuing applications.

Accordingly, no new matter has been introduced and entry of this amendment is respectfully solicited.

I. Effective Filing Date

The Examiner has alleged that the amendment filed by Applicants on August 9, 2002 changed the effective filing date of the instant application from June 30, 1995 to February 3, 1997. See, page 2, section 3. Applicants respectfully disagree.

Applicants note that the Examiner has provided no basis for her assertion that effective filing date of the instant application has changed. Contrary to the Examiner's statement, Applicants assert that the amendment filed on August 9, 2002 had no effect on the effective filing date to which the instant application is entitled. Thus, Applicants believe that the instant application is properly entitled to claim benefit to the filing date of the earliest filed application, that is, to the June 30, 1995 filing date of U.S. Provisional Application No. 60/000,602. Accordingly, Applicants respectfully request the Examiner for an appropriate correction of the record.

II. Rejections Under 35 U.S.C. § 102(e)

The Examiner has rejected claims 16-42, 44-47, 50, 51, 53, 71 and 76 under 35 U.S.C. § 102(e) as being anticipated by Moore et al. (U.S. 6,054,289, priority to August 30, 1996 (hereinafter "the '289 patent")). In particular, the Examiner alleges that the '289 patent discloses, but does not claim, a gene that is identical to the gene of the instant invention and thus anticipates the instant invention. *See*, pages 2-4, sections 4-5.

Applicants respectfully disagree and traverse this rejection. Preliminarily, as discussed above, Applicants disagree with the Examiner's contention that the instant invention is not entitled to earliest priority date of June 30, 1995. Thus, Applicants assert that the '289 patent is not a proper § 102(e) reference over the instant application.

Moreover, M.P.E.P. § 716.10 at 700-269 states that

> [w]hen subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. § 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention ... or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application.

Applicants point out that, with respect to the presently claimed subject matter, the '289 patent is not available as prior art for any purpose under 35 U.S.C. § 102. To support this contention, Applicants submit herewith an executed Declaration of Drs. Hongjun Ji and Craig A. Rosen under 37 C.F.R. § 1.131. This Declaration establishes that the disclosure of the '289 patent that relates to the presently claimed polynucleotides corresponding to Breast Cancer Specific Gene 1 (BCSG1) is the invention of Hongjun Ji and Craig A. Rosen. This Declaration further establishes that Paul A. Moore, Reiner L. Gentz, Jian Ni, and Jing-Shan Hu, co-inventors of the '289 patent, did not contribute to the conception of the presently claimed BCSG1 polynucleotides.

Since this Declaration establishes that the presently claimed invention is the invention of Dr. Ji and Rosen, the disclosure of the '289 patent with respect to the presently pending claims directed to the BCSG1 polynucleotides is not a publication "by others" and therefore is not prior art under 35 U.S.C. § 102. Since the '289 patent is a publication by the inventors within one year of the effective filing date of the relevant claims, the '289 patent is not available as prior art for any purpose under 35 U.S.C. § 102. *See, In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982); *Ex parte Lemieux*, 115 USPQ 148 (PTO Bd App. 1957). Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

III. Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 71-77 under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. In particular, the Examiner alleges that while the specification is enabling for polynucleotides encoding the amino acid sequence of SEQ ID NO:2, the specification does not reasonably provide enablement for polynucleotide variants of SEQ ID NO:2 or the cDNA clone of ATCC Deposit 97856, wherein the

variants have 95% identity or one to thirty amino acid substitutions and are overexpressed in breast cancer. *See*, page 5, section 6.

Applicants respectfully disagree. However, in the interest of facilitating prosecution, and in no way in acquiescence to the Examiner's rejections, have canceled claims 71-77 without prejudice or disclaimer. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Conclusion

Applicants respectfully request that the above-made remarks and amendments be entered and made of record in the file history of the instant application. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the allowance of this application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: March 14, 2005

Respectfully submitted,

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